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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,328	01/29/2004	Ji-hwan Lim	1793.1167	1248

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EXAMINER

COLEMAN, VANESSA V

ART UNIT	PAPER NUMBER
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2627

MAIL DATE	DELIVERY MODE
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08/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,328

Applicant(s)

LIM ET AL.

Examiner

Vanessa (Brandi) Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/20/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 43-48 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22, 25-33 and 37-42 is/are allowed.
- 6) ☒ Claim(s) 23, 24 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Claims 43-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 20, 2007.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23, 24, 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 23 and 24 are drawn to first and second light sources that are separately installed in regards to first and second photodetectors. However, paragraph [0036] of the specification discloses that the first and second light source 21 and 31 are separately installed from the first and second photodetectors 22 and 32 when the optical pickup includes "cubic beam splitters and/or plate-type beam splitters instead of the first and second holograms 23 and 33." Because Claims 23 and 24 depend from Claim 12, which is drawn to an optical pickup including a first and second hologram, the claims fail

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to meet the enablement requirement. Regarding Claims 34-36, Claim 34 is drawn to an optical pickup comprising a cubic beam splitter. Again referring to paragraph [0036] of the specification, a cubic beam splitter is disclosed as used "instead" of the first and second holograms 23 and 33. As with Claims 23 and 24, because Claim 34 is dependant on Claim 12, which is drawn an optical pickup including a first and second hologram, the claim fails to meet the enablement requirement. Claims 35 and 36 are drawn to a reflection element being installed on the cubic beam splitter of Claim 34 and a reflection element that is a coating on the surface of the cubic beam splitter of Claim 34. As with above, because Claims 35 and 36 depend from Claim 12, which is drawn to an optical pickup including a first and second hologram, and paragraph [0036] discloses that a cubic beam splitter is used instead of first and second holograms 23 and 33, the claims fail to meet the enablement requirement.

Allowable Subject Matter

4. Claims 1-22, 25-33, and 37-42 are allowed. None of the prior art of record, alone or in combination, discloses an optical pickup compatible with a two recording mediums of different formats that includes a first light source which emits a first light beam with a wavelength suitable for a first recording medium; a first hologram which changes the path of the first light beam, and a first photodetector which receives light reflected by a recording medium; and a second hologram optical module comprising; a second light source which emits a second light beam with a wavelength suitable for a second

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recording medium, a second hologram which changes the path of the second light beam, and a second photodetector, which receives light reflected by a recording medium; wherein the first photodetector monitors the amount of light emitted from the second light source by detecting a portion of a second light beam that is emitted from the second light source and incident on the first hologram optical module through a reflection process, and/or the second photodetector monitors the amount of light emitted from the first light source by detecting a portion of a first light beam that is emitted from the first light source and incident upon the second hologram optical module through a reflection process.

5. Claims 23, 24, and 34-36 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, ^{1st} ~~3rd~~ paragraph, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanessa (Brandi) Coleman whose telephone number is (571) 272-9081. The examiner can normally be reached on Mon-Thurs 8:30-6; 1st Fri off, 2nd Fri 8:30-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vanessa (Brandi) Coleman
Art Unit 2627

VC


WAYNE YOUNG
SUPERVISORY PATENT EXAMINER